

Appl. No. 09/580,233
Office Action mailed March 17, 2004
Response transmitted June 15, 2004

Attorney Docket No. 10022/15

REMARKS

1. Claims 1-27 are pending in the application. The Examiner has withdrawn the prior grounds for rejection under 35 U.S.C. § 103(a) and has found new grounds of rejection under 35 U.S.C. § 103(a). In addition, Claims 1-16 are rejected now for the first time under 35 U.S.C. § 101. Applicants traverse the rejections, and object to the finality of the rejections.

2. The present Office Action has been made final and includes at least one new ground of rejection, under 35 U.S.C. § 101. This new ground of rejection was not necessitated by Applicants' amendment of claims or on information submitted in an Information Disclosure Statement. Therefore, it is improper to make the Office Action final. M.P.E.P. 706.07(a). The Examiner is requested to withdraw the finality of the present Office Action.

3. Claims 1-16 are rejected now for the first time under 35 U.S.C. § 101, on grounds of non-statutory subject matter. The rejection states that method Claims 1-16 do not have practical application in the technological arts, and that all steps of the method could be performed using a pen and a paper. The rejection further states that the claims would be deemed statutory if they recited a connection to the technological arts. The Amendment to Claim 1, reciting a computer, overcomes the rejection. The Examiner is respectfully requested to withdraw the rejection of Claims 1-16 under 35 U.S.C. § 101.

4. Claims 1-27 are rejected under 35 U.S.C. § 103(a) as being unpatentable in view of U.S. Pat. No. 5,189,608 to Richard Lyons et al. ("Lyons") in view of U.S. Pat. No. 6,064,984 to Mark Ferguson et al. ("Ferguson") and further in view of U.S. Pat. No. 6,324,395 to Ali Khayrallah et al. ("Khayrallah"). Applicants traverse these rejections because, as explained in detail below, the references have been combined with improper hindsight and the references do not teach all the claimed limitations.

As to independent Claims 1 and 17, the rejection states that Lyons discloses a system for developing a business model and a method for providing financial analysis, and admits that Lyons does not mention a wireless service. Office Action, p. 3, last line, to p. 4, line 1. The Office Action also states that Lyons discloses accessing a reference database, and admits that Lyons does not

Appl. No. 09/580,233
Office Action mailed March 17, 2004
Response transmitted June 15, 2004

Attorney Docket No. 10022/15

disclose adjusting a standard adoption curve to obtain an adjusted adoption curve based on the accepted user-specific input. Office Action, p. 4, lines 20-21. The Office Action then cites Ferguson and Khayrallah for disclosing the missing material, with several reasons for combining references.

A. Combining these references constitutes impermissible hindsight

One reason advanced in the rejection for combining the references is that "one would have been motivated to use those steps in order to minimize the cost of the business by eliminating the need to develop multiple systems." Office Action, p. 4, lines 7-8. Other, somewhat contradictory reasons for combining include facilitating management decisions (Office Action, p. 5, lines 4-6), determining the risks of the business based on its cost and revenues (Office Action, p. 5, lines 15-16), and supporting management decisions (Office Action, p. 6, lines 2-4).

Lyons is directed to storing and generating financial data employing user-specified input and output formats; Ferguson is directed to a graphical user interface (GUI) for a computer-implemented financial planning tool; only Khayrallah pertains to wireless service, and Khayrallah is directed to assigning resource charges in wireless communication systems. Therefore, any analysis for obviousness of the present invention should begin with Khayrallah, not with the other references.

Khayrallah states that charges for wireless services should be commensurate with the resources associated with the service. Abstract, lines 1-4. In the passages cited in the rejection, Khayrallah also states that charges for the services should be based on the spectral and non-spectral demand placed by use of the services on the wireless communication system, such as bandwidth, extra hardware, extra software, operational complexity, and so on. Khayrallah, col. 12, line 55, to col. 13, line 2. Khayrallah's concept, in passages cited in the rejection, col. 4, lines 33-37, is that

both directly measurable cost indices such as power usage and bandwidth usage can be commensurately billed, as well as indirect costs attributable to the more complex and expensive equipment need to provide certain types of premium or robust services.

Khayrallah is thus directed to measuring already-incurred and ongoing costs. There is no suggestion whatever of cost estimates or of estimating potential revenue from providing enhanced wireless services.

Appl. No. 09/580,233
Office Action mailed March 17, 2004
Response transmitted June 15, 2004

Attorney Docket No. 10022/15

Furthermore, the rejection states that one would be motivated to combine Lyons with Khayrallah in order to "eliminate the need to develop multiple systems." Office Action, p. 4, lines 7-8. This flatly contradicts the proposition of the present invention, which is to estimate the potential for enhanced wireless communication services, not to eliminate the need for extra systems and services.

This combination of references constitutes impermissible hindsight, because the rejection takes unrelated words from several unrelated and contradictory references to create a mosaic resembling the present invention. This is impermissible. *W.L. Gore & Assoc. Inc. v. Garlock, Inc.*, 220 U.S.P.Q. 303, 312-13 (Fed. Cir. 1983) (reversing findings of obviousness and stating that it is impermissible hindsight to take individual, naked parts of several references to create a "mosaic" of the claimed invention). Accordingly, the references may not be combined because the combination constitutes impermissible hindsight and there is insufficient motivation to properly combine the references. M.P.E.P. 2143.

B. The references do not teach or suggest all the claim limitations

Independent Claims 1 and 17 relate to providing the user with a graphical depiction of a financial analysis that relates to adding additional services to an existing wireless communication system and developing a strategy for the deployment of the enhanced wireless communication services based on an analysis of several factors. As noted above, Khayrallah is directed to quantifying and charging proportionately for all existing costs in a wireless communication system. There is no teaching in Khayrallah for providing estimates of potential revenue or potential costs for adding additional or enhanced services. Furthermore, the rejection states that one would be motivated to combine Khayrallah with one of the other references, Lyons, "to minimize the cost of the business by eliminating the need to develop multiple systems." Thus, the rejection itself teaches against the addition of multiple systems and services as claimed in Claims 1 and 17.

Accordingly, the combination of references does not teach at least the steps of method Claim 1 that involve estimating or additional services. Those are the steps of accepting (which includes information about the enhanced wireless communication service), accessing (which includes "a second set of cost data values associated . . . with the enhanced wireless communication service), estimating (estimating at least one potential revenue value), and presenting a graphical

Appl. No. 09/580,233
Office Action mailed March 17, 2004
Response transmitted June 15, 2004

Attorney Docket No. 10022/15

depiction . . . of the at least one potential revenue value. Apparatus Claim 17 also recites limitations relating to the proposed enhanced systems, which are therefore not anticipated or made obvious by the three references. These include limitations of: a storage device containing . . . a standard adoption curve for adoption of the enhanced wireless communication service; a user input interface for accepting user-specific input relating to . . . the enhanced wireless communication service; an estimator . . . wherein the estimator includes a revenue estimator that generates an estimated revenue and a cost estimator that generates an estimated cost value.

In addition to not disclosing adding enhanced services, as discussed in the previous Amendment, Lyons does not disclose a standard adoption curve for adoption of the enhanced wireless communication service, and does not disclose adjusting the standard adoption curve. The standard adoption curve is part of the accessing limitation in Claim 1 and at least two limitations in Claim 17. Rather than disclosing an adoption curve, Lyons teaches accepting inputs relating to financial data that is organized into four classes or dimensions, i.e., Schedule, Entity, Period and Type (*see* Table V in Lyons). The rejection relies upon Lyons disclosure of templates, which are not adoption curves but are standard accounting inputs (Balance sheet, Income statement, Key Statistics, *see* Table VI). There is no disclosure of a standard adoption curve, or of anything that relates to potential revenue or costs of anything, let alone enhanced wireless communication services.

Moreover, the present rejection admits that Lyons does not disclose adjusting the standard adoption curve. Office Action, p. 4, lines 20-21. The rejection further states that one "would have been motivated to obtain an adjusted adoption curve in the wireless communication service, in order to facilitate the management decisions by using a graph that shows the business' current situation." Page 5, lines 4-6. Even if this were so, there is no suggestion of adjusting the curve for estimating at least one potential revenue value as claimed; and, as noted above, Lyons does not refer to wireless services.

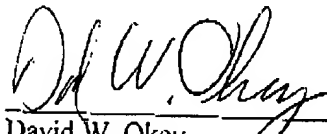
The references must teach or suggest all the limitations of the claimed invention, and the rejection admits that this step is not taught. Accordingly, the references do not teach or suggest all the limitations of Claims 1 and 17, or of claims depending from them, Claims 2-16 and 18-27. The Examiner is respectfully requested to withdraw rejections of Claims 1-27 and to allow the claims.

Appl. No. 09/580,233
Office Action mailed March 17, 2004
Response transmitted June 15, 2004

Attorney Docket No. 10022/15

5. Applicants thank the Examiner for withdrawing previous rejections. Applicants request the Examiner to withdraw the present rejections and to advance the application to allowance, or at least to withdraw the finality of the present Office Action. The Examiner is respectfully requested to telephone the below-listed attorney at 312-321-4200 if such communication would expedite this application or would be helpful to the Examiner.

Respectfully submitted,



David W. Okey
Registration No. 42,959
Attorney for Applicant

BRINKS HOFER GILSON & LIONE
One Indiana Square, Suite 1600
Indianapolis, IN 46204
Telephone: 317-636-0886
Facsimile: 317-634-6701